

REMARKS

Applicants would like to thank the Examiner for the courtesies extended to Applicants' representative during the telephonic interview of February 28, 2008. During that interview, the rejections contained in the Office Action mailed on October 23, 2007, were discussed. The substance of the interview has been incorporated into this response.

In the Office Action¹, the Examiner rejected claims 47-121 under 35 U.S.C. § 101 as being directed to a non-statutory subject matter; rejected claims 47-121 under 35 U.S.C. § 112, second paragraph; and rejected claims 47-121 under 35 U.S.C. § 103(a) as being unpatentable over a first reference entitled "Information on Realtor Workstation ("Realtor Workstation") in view of a second reference entitled "Information on Homes Database" ("Homes Database") and an article by Judith Motti entitled "Customer Tracking: It's Not Just Web-site Hits" ("Motti").

Applicants respectfully traverse these rejections. However, in this Amendment, Applicants have amended claims 47, 48, 50-58, 60-64, 66-91, 93-96, 98-119, and 121 in accordance with the Examiner's suggestions at the interview to expedite prosecution of this application and without acceding to the outstanding rejections. Applicants have also added new claims 122-128. Upon entry of this Amendment, claims 47-128 will remain pending and under current examination. Applicants respectfully submit that these claims are allowable for the reasons set forth below.

¹ The Office Action contains a number of statements reflecting characterizations of certain references and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

I. The Rejection of Claims 47-121 under 35 U.S.C. § 101

Applicants respectfully traverse the rejection of claims 47-121 under 35 U.S.C. § 101. While Applicants respectfully disagree, Applicants have amended the claims in accordance with the Examiner's suggestions at the interview in an effort to expedite prosecution of this application. Indeed, the Examiner agreed that the amendments would overcome the rejection under § 101.

A. Claims 47-85

For example, in the Office Action, the Examiner indicated that claims 47-85 fail to comply with § 101 because "there is no association of a client to an agent" (Office Action, p. 3). Amended claim 47 recites, *inter alia*, a computer-implemented method of providing client-accessed real estate to "a real estate professional associated with the client," thus addressing the Examiner's concern.

The Examiner also alleged that claims 47-85 fail to comply with § 101 because they do not recite "creating the association in the server" and "storing of client's property access information" (Office Action, p. 3). Amended claim 47 recites, *inter alia*, "storing an account for the client" and "generating and storing client-accessed real estate information in response to the actions of the client," thus addressing the Examiner's concern.

Finally, the Examiner alleged that claims 47-85 fail to comply with § 101 because they fail to recite "enabling only the associated agent of the client to have access to the client specific information." (Office Action, p. 3). Amended claim 47 recites, *inter alia*, "the account being authorized by the professional" and "providing at least some of the

client-accessed real estate information to the professional,” thus associating the agent with the client and giving the agent access to the client-accessed information.

Applicants note that, in addition to the amendments discussed above, claim 47 recites at least the useful, concrete, and tangible result of “providing at least some of the client-accessed real estate information to the professional, thereby providing the professional with knowledge of the actions of the client when the client accesses the account.”

Applicants respectfully submit that for at least the reasons discussed above, claim 47 recites statutory subject matter in compliance with § 101. Claims 48-85 appear to have been rejected solely due to their dependence from claim 47. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 47-85 under § 101.

B. Claims 86-121

Claims 86-121 were rejected for reasons similar to those discussed above with respect to claims 47-85. Claim 86 has been amended in a similar fashion to claim 47, and recites statutory subject matter in compliance with § 101. Claims 87-121 appear to have been rejected solely due to their dependence from claim 86. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 86-121 under § 101.

II. The Rejection of Claims 47-121 Under 35 U.S.C. § 112

Applicants respectfully traverse the rejection of claims 47-121 under 35 U.S.C. § 112, second paragraph. The Examiner’s rejection under 35 U.S.C. § 112 is based on the same reasons as the § 101 rejection (Office Action, p. 4). While Applicants

respectfully disagree, Applicants have amended the claims in accordance with the Examiner's suggestions at the interview in an effort to expedite prosecution of this application. Indeed, the Examiner agreed that the amendments would overcome the rejection under § 112. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 47-121 under § 112.

III. The Rejection of Claims 47-121 Under 35 U.S.C. § 103(a)

Claims 47-121 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Realtor Workstation* in view of *Homes Database* and *Motti*. Applicants respectfully traverse this rejection because the Office Action has not established that the *Realtor Workstation* and *Homes Database* references are prior art to this application and because a *prima facie* case of obviousness has not been established. Indeed, the Examiner agreed that the claims, as amended, would overcome the rejection under § 103(a). Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 47-121 under § 103(a).

A. Realtor Workstation and Homes Database Are Not Prior Art

Applicants respectfully submit that the Office Action has not established that *Realtor Workstation* and *Homes Database* are prior art to this application. This application was filed on November 28, 2000, and claims the benefit of U.S. Provisional Application No. 60/200,169, filed April 27, 2000. However, the *Realtor Workstation* and *Homes Database* references that were mailed with the Office Action appear to be dated after April 27, 2000.

For example, the *Realtor Workstation* reference includes of a number of computer printouts, most of which have a date of December 2004. Although page 1 of

the reference bears an image of a CD with a date of "2000," it is not clear whether the reference to "2000" is before the April 27, 2000, priority date of this application. Similarly, the *Homes Database* reference includes a number of computer printouts, some of which do not predate the April 27, 2000, priority date of this application.

Accordingly, Applicants respectfully submit that the Office Action has not established that *Realtor Workstation* and *Homes Database* are prior art to this application and request that the rejection under § 103(a) be withdrawn.

B. A Prima Facie Case of Obviousness Has Not Been Established

Even assuming that *Realtor Workstation* and *Homes Database* are prior art to this application, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and request that the outstanding rejection under § 103(a) should be withdrawn for this additional reason. The key to supporting any rejection under § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. *See id.*

Moreover, "[a] conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III) (internal citation omitted). Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103

is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (internal citations omitted) (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1996) The factual inquires . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

In this application, a *prima facie* case of obviousness has not been established at least because the Examiner has neither properly determined the scope and content of the applied art nor properly ascertained the differences between the claimed invention and the applied art. Accordingly, the Office Action has failed to clearly articulate a reason why the applied art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Moreover, a *prima facie* case of obviousness has not been established at least because the differences between the applied art and Applicants’ claims are such that it would not have been obvious for one of ordinary skill in the art at the time of the invention to modify the applied art to arrive at Applicants’ claimed invention. For example, independent claim 47 is directed to a computer-implemented method of providing client-accessed real estate information to a real estate professional associated with the client and recites a combination of features, including “providing at

least some of the client-accessed real estate information to the professional, thereby providing the professional with knowledge of the actions of the client when the client accesses the account." None of the applied references, including *Realtor Workstation*, *Homes Database*, and *Motti*, either singly or in combination, teaches or suggests such a combination of features.

Indeed, the Examiner concedes that *Realtor Workstation* "does not teach . . . providing real estate information to . . . clients" (Office Action, p. 5). As *Realtor Workstation* does not provide real estate information to clients, *Realtor Workstation* cannot provide client-accessed real estate information to a professional. Therefore, *Realtor Workstation* does not teach or suggest "providing at least some of the client-accessed real estate information to the professional, thereby providing the professional with knowledge of the actions of the client when the client accesses the account," as recited by claim 47.

Homes Database fails to cure the deficiencies of *Realtor Workstation*. *Homes Database* discloses a tool that allows a user to search for homes in the Mid-Atlantic states (*Homes Database*, p. 2). *Homes Database* also discloses a link that allows a user to find a real estate professional (*Homes Database*, p. 3). However, *Homes Database* does not disclose or suggest that any information related to actions taken by the user are provided to the real estate professional. Therefore, *Homes Database* does not teach or suggest "providing at least some of the client-accessed real estate information to the professional, thereby providing the professional with knowledge of the actions of the client when the client accesses the account," as recited by claim 47.

Motti also fails to cure the deficiencies of *Realtor Workstation* and *Homes Database*. *Motti* discloses using “tracking tools and services to monitor customer actions” (*Motti*, p. 1). *Motti* also discloses capturing the length of time users spend on pages, and their entry and exit URL’s (*Motti*, p. 2). However, *Motti* does not disclose or suggest providing any information from about a client to an associated real estate professional. Moreover, *Motti* discloses that the data are metrics about various websites (*Motti*, p. 3), and does not suggest that any data about an individual user can be reviewed by another party. In contrast, claim 1 provides “the professional with knowledge of the actions of the client”, not simply anonymous metrics. Therefore, *Motti* does not teach or suggest “providing at least some of the client-accessed real estate information to the professional, thereby providing the professional with knowledge of the actions of the client when the client accesses the account,” as recited by claim 47.

Because none of the applied references, including *Realtor Workstation*, *Homes Database*, and *Motti*, either singly or in combination, teaches or suggests at least “providing at least some of the client-accessed real estate information to the professional, thereby providing the professional with knowledge of the actions of the client when the client accesses the account,” as required by claim 47, a *prima facie* case of obviousness has not been established. Claim 47 is therefore allowable.

Independent claim 86, although of different scope from claim 47, recites features similar to those discussed above with respect to claim 47, features which are also not rendered obvious by the applied references. Accordingly, claim 86 is also allowable. Claims 48-85 depend from claim 47, and claims 87-121 depend from claim 86. These dependent claims are allowable at least because they depend from claims 47 or 86,

which are allowable for the reasons discussed above. Therefore, Applicant respectfully requests the Examiner to withdraw the rejection under § 103(a) and allow claims 47-121.

IV. New Claims 122-128

New independent claims 122-25, although of different scope from claim 47, recite features similar to those discussed above with respect to claim 47, features which are also not rendered obvious by the applied references. Accordingly, Applicants respectfully submit that these claims are allowable.

New independent claims 126-28 are also allowable because none of the applied references, including *Realtor Workstation*, *Homes Database*, and *Motti*, alone or in combination, teaches or suggests at least "providing at least some of the professional-accessed real estate information to the client, thereby providing the client with knowledge of the actions of the professional when the client accesses the account," as required by claims 126-28.

V. Conclusion

In view of the foregoing remarks and amendments, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims. Applicants appreciate the Examiner's courtesy in considering all of the issues raised by the present examination of the application during the interview and in making suggestions to place the application in a condition for allowance. Applicants believe that the above amendments and remarks overcome the rejections of record and present claims that are patentable over the prior art, including the art made of record through an Information Disclosure Statement, filed contemporaneously with this response.

Should the Examiner after consideration of this response believe that any additional issues need to be addressed to place the case in condition for allowance, Applicants encourage the Examiner to contact Applicants' undersigned representative by telephone to discuss any remaining issues or to resolve any misunderstandings.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 12, 2008

By: 
Naveen Modi
Reg. No. 46,224